

REMARKS

By this response, Applicants amend claims 3, 4, and 29 to more appropriately define the instant invention. Claims 1-7 and 29 are pending.

In the Final Office Action dated April 23, 2003, the Examiner rejected claims 1-7 and 29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,517,004 to *Good et al.* ("*Good*") in view of U.S. Patent No. 5,770,841 to *Moed et al.* ("*Moed*"). Applicants traverse the Examiner's rejection, as discussed below.

Applicants submit that a *prima facie* case of obviousness has not been established with respect to claims 1-7 and 29. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. (See M.P.E.P. § 2143.03 (8th ed. 2001).) Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, and not be based on applicant's disclosure." (M.P.E.P. § 2143 (8th ed. 2001) emphasis added.)

The Examiner alleges that *Good* discloses substantially the elements recited in independent claim 1. The Examiner concedes that *Good* fails to "teach an image capture system" but relies on *Moed* to cure the deficiency (Final Office Action, page 3). Applicants disagree with the Examiner's conclusions.

Good describes an "automated package identification and measuring system" (Abstract). As the Examiner concedes, *Good* fails to disclose "an image capture system for producing time-

dependent images of the objects,” as recited in claim 1. For at least this reason, claim 1 is patentable over *Good*.

Moreover, even if *Good*’s deficiencies were curable by *Moed* (to which Applicants do not acquiesce) a *prima facie* case of obviousness has not been established. Applicants submit that, absent Applicants’ disclosure, a skilled artisan would not have been motivated or equipped to combine *Good* and *Moed* in a manner resulting in Applicants’ claimed invention. As M.P.E.P. § 2143.01 makes clear, the mere fact that references can be combined is insufficient to establish a *prima facie* case of obviousness. For at least these reasons, a *prima facie* case of obviousness has not been established for claim 1, and Applicants deem claim 1 patentable.

Further, Applicants remind the Examiner that determinations of *prima facie* obviousness must be supported by a finding of “substantial evidence.” See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Specifically, unless “substantial evidence” found in the record supports the factual determinations central to the issue of patentability, including motivation, the rejection is improper and should be withdrawn.

In this case, Applicants submit that there is no “substantial evidence” in the record to support the combination of *Good* and *Moed*, and the requisite “clear and particular” motivation required to support a *prima facie* case of obviousness is lacking. The Examiner merely provides a limitation-by-limitation analysis, pointing out where the references teach the individual limitations, but fails to provide more than conclusory statements supporting a motive for choosing Applicants’ claimed combination. For example, the Examiner alleges:

[i]t would have been obvious to one of ordinary skill in the art...to incorporate the image capture system as taught by *Moed* to the...system of *Good* in order to provide an improved and an enhanced means wherein operator(s) can verify the package in the scanning terminal using the image of the package displayed on the display device (Final Office Action, page 3).

The Examiner further alleges that the supposed combination would provide alternative means for reading/decoding the characters...from [a] package using the optical character recognition (OCR) techniques..." *Id.*

Neither *Good* nor *Moed* describe any such "alternative" reading/decoding means or "enhanced means" for enabling an operator to verify a package in a scanning terminal. *Moed* merely mentions validating a destination address via a database. *Good*, in fact, teaches away from the Examiner's alleged combination: *Good* explicitly states: "[a]n object of the present invention is to provide an automated...system which...[does] not require any human intervention" (col. 4, lines 3-6 (emphasis added)). Moreover, the Examiner points to no evidence supporting the notion that a skilled artisan having *Good* before him would have been concerned with enabling an operator to verify packages or providing an alternative means for reading and decoding. For at least these reasons, the Examiner fails to meet the burden for establishing a *prima facie* case of obviousness.

Similar to claim 1, independent claim 29 recites a combination of elements including "an image capture system for producing images of the objects." Claim 29 is patentable for at least the reasons presented above in connection with claim 1.

Moreover, claim 29 recites, *inter alia*:

orientation means for determining an orientation of each object on the transport means using at least...positional information [associated with the transport means]; [and]

information capture means for obtaining information from each object, wherein the image capture means includes a plurality of scanning means and wherein each scanning means is simultaneously focused based on the orientation of the objects on the transport means.

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Neither *Good* nor *Moed*, nor any combination thereof, teaches or suggests at least the above claimed features. For at least this reason, claim 29 is patentable over the cited prior art.

Claims 2-7 depend from allowable base claim 1 and are patentable at least by virtue of such dependency. For at least the foregoing reasons, Applicants request withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of claims 1-7 and 29.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-7 and 29 in condition for allowance. The proposed amendments to claim 29 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, entry of the amendment to claim 29 would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

The claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: October 20, 2003

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